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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/654,933 | 09/01/2000 | Jay S. Walker | 96-108XX | 7050 |

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| EXAMINER | |
|---|---|
| COLBERT, ELLA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3696 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/22/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/654,933 | WALKER ET AL. | |
| | Examiner | Art Unit | |
| | Ella Colbert | 3696 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *14 October 2008*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *49-62,70 and 73-80* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *49-62,70 and 73-80* are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

1. Claims 49-62, 70, and 73-80 are pending in this communication filed 10/14/08 entered as Response to Election/Restriction and Request for Extension of Time.

2. The Election/Restriction mailed 7/11/08 is hereby withdrawn in view of the Interview conducted on 10/23/08 with the Examiner and the Examiner's Supervisor.

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 49-62, drawn to a method, an apparatus, and a medium encoded with a program for implementing a method for determining a first value for a parameter, determining a second value for the parameter, calculating a payment, and providing an offer to a customer associated with the credit account, classified in class 705, subclass 35.

II. Claims 70 and 73-79, drawn to a method, an apparatus, and a medium encoded with a program for implementing a method for determining that a customer associated with a credit account is dissatisfied, determining at least one term of the credit account, determining a payment to offer the customer, and presenting the customer with an offer, classified in class 705, subclass 77.

III. Claim 80, drawn to a method for determining a current value for a parameter, determining a value for the parameter, calculating a payment, receiving an indication that the customer agrees, and providing the payment to the customer, classified in class 705, subclass 39.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions have different scopes, furthermore they have different modes of operation thus yielding different effects and are not capable of use together for the reason set forth.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

**(b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;**

**(c) the inventions require a different field of search** (for example, searching different classes/subclasses or electronic resources, or **employing different search queries**);

**(d) the prior art applicable to one invention would not likely be applicable to another invention**;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention**.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

**If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.**

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

"Under the statue, the claims of an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct." See MPEP 803.

***Response to Arguments***

Applicants' arguments filed 10/14/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Applicants' point out that this is the second time that a Panel Decision has been issued during the prosecution of this application ordering prosecution be reopened (the first being mailed March 24, 2006) and Applicants' also point out that this case has been pending now for over eight years, and this is the second time that the Examiner has issued a Restriction Requirement concerning claims 49-62, 70, and 73-80 has been considered. Response: The Examiner disagrees in part regarding the application being pending for over eight years because it has only been over eight years from the date of file but not eight years in the examination process. However, if Applicants' were more willing to amend the claims to move the application forward, the application could be closer to allowance or allowed.

This restriction is being given as agreed in the interview on October 23, 2008 with Applicants' representatives, the Examiner, and the Examiner's Supervisor. Hopefully, this will be the last restriction requirement unless Applicants' add more claims and the claims are so independent or distinct that the claims require restriction.

Whichever claims are elected without or with traverse will be given a very through examination on the merits and any rejections necessary in accordance with the

MPEP and case law will be given. Applicants' will then be given an opportunity to amend the claims to move the application forward.

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed …". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

"However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified." *In re Prater*, 162 USPQ 541 (CCPA 1969).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

January 15, 2009

| Application Number | Application/Control No. | Applicant(s)/Patent under Reexamination | |
|---|---|---|---|
| | 09/654,933 | WALKER ET AL. | |
| | Examiner | Art Unit | |
| | Ella Colbert | 3696 | |